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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,033	08/28/2001	Wayne D. Woodruff	D2622	5727

27774 7590 03/06/2006

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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,033

Applicant(s)

WOODRUFF, WAYNE D.

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_ P.C. 2-28-06

### **DETAILED ACTION**

1. Claims 1-24 are pending in this application and have been examined.

#### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because: each of figures 1-6 are hand drawn, informal, and non-compliant. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al., US 6,968,364.

As for claim 1, Wong teaches a method for secure recording and playback of Multi-media programming by a recording device (abstract, col. 3 lines 36-49, col. 4 lines 38-47): comprising: inputting a recording authorization instruction into a recording device (col. 13 lines 1-3: "DVR", col. 13 lines 10-27, col. 14 lines 37-50: DVR is operable to receive a token that facilitates programming of the DVR to record a specific program, col. 15 lines 13-25, col. 15 lines 48-62: authorization method is described which reads on "secure" recording and "authorization", col. 16 lines 12-20), said authorization instruction operating to authorize activation of a recording mechanism component of said recording device (col. 22 lines 5-22: authenticated token directs PVR to record); recording said at least one Multi-media program (col. 22 lines 10-12); inputting a playback authorization instruction into said recording device (col. 22 lines 29-39: data with "encrypted element" of token operates to authorize playback or disallow playback), said playback authorization instruction operative to authorize the activation of a playback mechanism component of said recording device (col. 22 lines 29-39); and playing back said at least one Multi-media program (col. 22 lines 29-39).

As for claim 2, Wong teaches the method according to claim 1 wherein said recording authorization instruction and said playback authorization instruction are identical (col. 22 lines 5-39: Wong teaches use of the same authenticated authorization token to allow recording and / or playback).

As for claim 3, Wong teaches the method according to claim 1 wherein said recording authorization instruction comprises a first password (col. 15 lines 57-59: Wong teaches a password that is included within a token).

As for claim 4, Wong teaches the method according to claim 1 wherein said at least one Multi-media program comprises one of Cable broadcasts, Satellite broadcasts and television programs broadcast in at least one of UHF, VHF, HDTV transmission formats (col. 1 lines 58-61).

As for claim 5, Wong teaches the method according to claim 1 wherein said recording device includes a storage component comprising a hard disk (col. 2 line 17: media content storage in a PVR hard disk is taught).

As for claim 7, Wong teaches the method according to claim 1 further including a step of designating a specific Multi-media program as restricted (col. 22 lines 26-39: Use of the token to designate the program as restricted to playback by authorized paying customers, or to restrict playback to a designated number of times or a certain time period is taught).

As for claim 8, Wong teaches the method according to claim 7, further including a step of playing back said restricted Multi-media program upon receipt of said playback authorization instruction (col. 22 lines 26-39).

As for claim 9, Wong teaches a method for the secure recording and playback of Multi-media programming by a recording and playback device (abstract, col. 3 lines 36-49, col. 4 lines 38-47) comprising: designating specific Multi-media programs as restricted (col. 22 lines 26-39: Use of the token to designate the program as restricted to playback by authorized paying customers, or restrict playback to a designated number of times or a certain time period is taught), said restricted Multi-media programs requiring at least one of a playback authorization instruction and a recording authorization instruction to authorize said recording device to one of record and playback said restricted Multi-media programs (col. 22 lines 4-39); inputting said recording authorization instruction into said recording device (col. 22 lines 9-11), said recording authorization instruction operative to authorize activation of a recording mechanism component of said recording device (col. 22 lines 9-11); recording at least one of said restricted Multi-media programs (col. 22 line 33: "recorded program"); and inputting a playback authorization instruction into said recording device (col. 22 lines 22-29: token may contain an encryption element that allows playback) , said playback authorization instruction operative to authorize activation of a playback mechanism component of said recording device (col. 22 lines 22-39).

As for claim 10, Wong teaches the method according to claim 9 wherein said recording authorization instruction and said playback authorization instruction are

identical (col. 22 lines 5-39: Wong teaches use of the same authenticated authorization token to allow recording and / or playback).

As for claim 11, Wong teaches the method according to claim 9 wherein said recording authorization instruction comprises a first password (col. 15 lines 57-59: Wong teaches a password that is included within a token).

As for claim 13, Wong teaches a device for the secure recording of Multi-media programs comprising: a programmable recording device, said recording device having 1) a recording mechanism, and 2) a playback mechanism (col. 3 lines 35-65, fig. 1A: a programmable recording system is shown, col. 4 lines 62-64: "FIG. 1A"), said recording mechanism adapted to record Multi-media programming (col. 3 lines 35-40), said playback mechanism adapted to playback recorded Multi-media programs (col. 13 lines 10-13); and a programming control interface, said programming control interface operative to selectively 1) activate said recording mechanism in response to a first user authorization instruction, and 2) selectively activate said playback mechanism in response to a second user authorization instruction (col. 13 lines 20-34: system includes a set-top box that provides a graphical user interface (GUI) controllable by a remote device through an IR link), wherein 1) recording of said Multi-media programs requires said first user authorization instruction to be entered into said programming control interface thereby activating said recording mechanism and permitting said Multi-media programs to be recorded (col. 22 lines 5-22), and 2) playback of said recorded

Multi-media programs requires said second user authorization to be entered into said programming control interface thereby activating said playback mechanism and permitting said recorded Multi-media programs to be played (col. 22 lines 23-39).

As for claim 14, Wong teaches the device according to claim 13 wherein said Multi-media programs comprise one of Cable broadcasts, Satellite broadcasts and television programs broadcast in at least one of UHF, VHF and HDTV transmission formats (col. 1 lines 58-61).

As for claim 15, Wong teaches the device according to claim 13 wherein said first user authorization instruction and second user authorization instruction are identical (col. 22 lines 5-39: Wong teaches use of the same authenticated authorization token to allow recording and / or playback).

As for claim 16, Wong teaches the device according to claim 13 wherein said recording authorization instruction comprises a first password (col. 15 lines 57-59: Wong teaches a password that is included within a token).

As for claim 18, Wong teaches the device according to claim 13 further including an interface for receiving Multi-media programs selectively designated as restricted (fig. 7: element 430, fig. 8 "Token Schema, col. 22 lines 23-39: receipt of tokens with an



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encryption element that contains data that restricts playback to paying customers, or to a designated time period, or a designated number of times).

As for claim 19, Wong teaches the device according to claim 18 wherein said device is arranged to playback said restricted Multi-media program upon receipt of said playback authorization instruction (col. 22 lines 23-39).

As for claim 20, Wong teaches a method for the secure recording and playback of Multi-media programming by a recording and playback device (abstract, col. 3 lines 36-49, col. 4 lines 38-47): comprising: designating specific Multi-media programs as restricted (col. 22 lines 23-39), inputting a playback authorization instruction into said recording device (col. 22 lines 23-39), said playback authorization instruction operative to authorize activation of a playback mechanism component of said recording device, and playing back said restricted Multi-media programs (col. 22 lines 23-39).

As for claim 21, Wong teaches the method according to claim 20 wherein said first user authorization instruction and second user authorization instruction are identical (col. 22 lines 5-39: Wong teaches use of the same authenticated authorization token to allow recording and / or playback).

As for claim 22, Wong teaches the method according to claim 20 wherein said recording authorization instruction comprises a first password (col. 15 lines 57-59: Wong teaches a password that is included within a token).

As for Claim 24, Wong teaches a programming control interface (col. 13 lines 20-34: system includes a set-top box that provides a graphical user interface (GUI) controllable by a remote device through an IR link) for use with a recording device having a recording mechanism and a playback mechanism (abstract, col. 3 lines 36-49, col. 4 lines 38-47), comprising: 1) a recording activator for activating said recording mechanism in response to a first user authorization instruction (col. 22 lines 5-22), and 2) a playback activator for selectively activating said playback mechanism in response to a second user authorization instruction (col. 22 lines 23-39) , wherein 1) the programming control interface is adapted such that the recording of said Multi-media programs requires said first user authorization instruction to be entered into said programming control interface thereby activating said recording mechanism and permitting said Multi-media programs to be recorded (col. 22 lines 5-22: authenticated token directs PVR to record; recording said at least one Multi-media program, col. 22 lines 10-12), and 2) playback of a recorded Multi-media program requires said second user authorization instruction to be entered into said programming control interface thereby activating said playback mechanism and permitting said recorded Multi-media programs to be played (col. 22 lines 23-39).

As for claims 6, 12, 17, and 23, Wong teaches the method according to claims 1, 9, and 20 wherein said playback authorization instruction comprises a second password (col. 22 lines 23-39: Wong teaches use of a first password for authentication, and an optional separate encryption data field or "token encryption element" containing a decryption key necessary to view the program even in the event that the token is authenticated and accepted by the PVR and thereby allow recording.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems for controlling the recording and or playback of multi-media content similar to the instant invention and are pertinent to the Applicant's disclosure:

Vogel	4,930,158
Yarbrough et al.	4,305,101
Brian et al.	5,548,345
Jackson	5,963,264
Olivo, Jr.	5,172,111

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

2-28-06

*Paul Callahan*

*E. Moise*  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER